UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,800	10/27/2000	Kenneth Snowdon	476-1951	5134

7590 02/11/2004

Mark D. Saralino, ESQ
RENNER, OTTO, BOISSELLE & SKLAR
1621 EUCLID AVENUE, 19TH FLOOR
Cleveland, OH 44115

EXAMINER	
HOFFMANN, JOHN M	

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/698,800	SNOWDON ET AL.	
	Examiner	Art Unit	
	John Hoffmann	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5,7-9,35 and 36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *35 and 36* is/are allowed.

6)☒ Claim(s) *1,5 and 7-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1-23-04 has been entered.

Allowable Subject Matter

Claims 35-36 are allowed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,5,7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 7 refers to "the adjacent coating". There is no antecedent basis for this. It is unclear if such requires adjacent.coating - or if it is to be interpreted as "if there is adjacent coating, then... In line 5, "the coating" has already been removed. It is suggested that line 5 refers to something like - removing at least a portion of the

coating. Line 7 could indicate not melting any coating that isn't removed. Examiner notes that even if some of the coating is burnt or melted, there would be lots of other "adjacent coating" that is not damaged.

Claim 1, line 6: there is no antecedent basis for "the region". Referring to "the region" suggests there is only one region. Typically, anyone can designate any section to be a region. Examiner could not find any definition for "region" in the specification which signifies that there a specific region. Moreover, one of ordinary skill would be unable to tell if a particular point is in the region or not. If something is 5 cm away, is it still in the region?

Claim 5: there is no antecedent basis for "the step of heating the preform", "the bond" or "the vicinity." The preposition "to" is used in lines 6, 7 and 8 of claim 1. "To" can be used as a function word to indicate a purpose or to indicate a result. Both are reasonable interpretations. However, the first sense (i.e. to indicate a purpose) is broader than the second. Since the PTO uses the broadest reasonable interpretation, it is deemed that "to generate sufficient heat" is merely an purpose: this is not equivalent to a step of "(thereby) generating sufficient heat." Therefore, claim 1 does not positively recite "melting" and "generating", there is no actually melting or generating.

It is unclear if the induction currents of this claim 5 is in addition to the current flows which were induced in claim 1 - or if they are additional.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5, 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to recite that coating is not melted. It does not appear to be support for this specific scope. Whereas examiner found support for a much broader scope i.e. "prevents damage", examiner could not find support for the specific no melting. In other words, there is no support for a method which permits other sorts of damage, but no melting.

Claims 1 and 7 refer to the preform being "immediately adjacent". Examiner could find no support for this limitation. Figure 2 suggest that they are not immediately adjacent.

The above constitute a prima facie showing of lack of support. The burden is now on Applicant to demonstrate that there is support.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 5, 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeVore 5658364 in view of Yamauchi 5515473.

DeVore discloses the invention as claimed, except for the low melting-point preform. Yamauchi discloses that using high melting point glass causes problems: col. 1, lines 55-61. The melting temperature of the Yamauchi is 430 C (col. 6, line43) or at least no higher than 440 C (col. 5, line 30). It would have been obvious to use the Yamauchi glass in the DeVore method, so as to prevent the higher temperatures from influencing the fiber. Alternatively, it would have been obvious to use the use a low melting point glass - because the lower the temperature, the lower the chance of damaging the fiber.

See col. 3, lines 12-33 of DeVore for the rest of the limitations. As to the various limitations regarding what objects are brought into position relative to other objects: the order of adding ingredients is generally not a patentable distinction. New and unexpected results is the most common secondary consideration to demonstrate an exception to this.

Claim 5 is clearly met.

Claim 7 is met for the same reasons claim 1 is. Further, see col. 3, line 4.

Claims 8-9: Figure 6 of Yamauchi indicates that about 490C is the lower limit for the specific conditions that Yamauchi uses. It would have been obvious to use an even lower melting point glass than Yamauchi uses (and thus use a lower processing temperature) so as to further reduce the risk of damage to the fiber. It is noted that if Applicant argues that one would not know how to create a lower melting point sealing

glass, such may be used as evidence that one would not be enabled to make and use applicant's invention - beyond the specific compositional teachings. In other words, there may be a question as what scope is presently enabled. Presently, all the claims are deemed to be enabled.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

IT is argued that DeVore uses insulation and the present invention does not. This is not persuasive. The claims are comprising in nature and are open to using insulation. Examiner can find nothing in the present claims which preclude the use of insulation.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tanno is cited as being directed to bonding glasses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John Hoffmann 2-05-04
Primary Examiner
Art Unit 1731

jmh